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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/748,148	12/31/2003	Masaki Okuyama	247103US0	6857

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OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.
1940 DUKE STREET
ALEXANDRIA, VA 22314

EXAMINER

VENKAT, JYOTHSNA A

ART UNIT	PAPER NUMBER
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1615

NOTIFICATION DATE	DELIVERY MODE
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07/25/2007

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/748,148

Applicant(s)

OKUYAMA ET AL.

Examiner

JYOTHSNA A. VENKAT Ph. D

Art Unit

1615

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 May 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2 and 4-8 is/are rejected.
- 7) ☒ Claim(s) 3 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 3/30/2004.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

Receipt is acknowledged of election filed on 5/14/07.

All the claims are examined, since there is no art for the elected group I. Claims 1-8 are pending in the application and the status of the application is as follows:

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 7-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 7 is unclear as to applicant's intent and claim lacks antecedent basis. In claim 3, the polypropylene fibers are treated with silicic anhydride and claim 7 depends on claim 3 and in claim 7 the polypropylene fibers are treated with fluorine compound. Are the polypropylene fibers treated with both silicic anhydride and fluorine compound? Claims 7 and claim 8, which depends on claim 7 does not particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-2 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of JP 2002-154932, machine translated text submitted by applicants (JP '932) and U. S. Patent 6,491,931 ('931).

Instant application is claiming a cosmetic composition comprising:

1. polypropylene fibers or polypropylene fibers treated with fluorine compound
2. oil soluble resin

JP '932 teaches eyelash cosmetic using oil soluble resin and fibers treated with fluorine compound. See the abstract, see page 2 paragraph 9 for fibers. The fibers are nylon fibers, rayon fibers, cellulose fibers and polyester fibers. See paragraphs 12-22 for the fibers treated with various fluorine compounds. See paragraphs 6-7 for oil soluble resin. The difference between the JP '932 and instant application is JP '932 does not teach polypropylene fibers treated with fluorine compound. However patent '931 teaches cosmetic composition using fibers and film forming polymer. Film forming polymers are also oil soluble resins. See the abstract; see col.2, ll 5-15 for the length of the fiber. Patent at col.2, ll 15-35 teaches various fibers and teaches equivalency between fibers of JP '931 and claimed polypropylene fibers. Patent '931 at col.2, ll

36-37 teaches that the fibers can be surface treated. See col.3, ll 5 through col.4, ll 27 for the film-forming polymer. See examples drawn to mascara.

Accordingly it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the composition of JP '932 using oil soluble resin and substitute fibers treated with fluorine compound of JP with polypropylene fibers and treat these fibers with fluorine compound in view of the equivalency between the fibers of JP and polypropylene fibers taught by patent '931 in mascara compositions. The idea of combining the ingredients flows logically from the art. This is a prima facie case of obviousness.

Claims 5-6 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of JP 2002-154932, machine translated text submitted by applicants (JP '932) and U. S. Patent 6,491,931 ('931) as applied to claims 1-2 and 4 above, and further in view of JP 2002-284642, machine translated text (JP '642).

Both the documents cited above do not teach the limitation, where in the oil soluble resin is obtained by fractionation of candelilla wax. However JP '642 teaches claims 5-6 limitation and using this resin in cosmetics. See paragraphs 1-9. See also paragraph 15.

Accordingly it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the composition of JP '932 using oil soluble resin and substitute fibers treated with fluorine compound of JP with polypropylene fibers and treat these fibers with fluorine compound in view of the equivalency between the fibers of JP and polypropylene fibers taught by patent '931 in mascara compositions and use oil soluble resin of JP 642. One of ordinary skill in the art would be motivated to modify the compositions of JP and use polypropylene fibers and use oil soluble resin of '642 with the reasonable expectation of success

that the compositions has excellent eyelash curling effect and the presence of specific oil soluble resin of claims 5-6 provide the advantage of providing a film that is excellent in adhesion to skin. This is a prima facie case of obviousness.

Allowable Subject Matter

Claim 3 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JYOTHSNA A. VENKAT Ph. D whose telephone number is 571-272-0607. The examiner can normally be reached on Monday-Friday, 10:30-7:30:1st Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, MICHAEL WOODWARD can be reached on 571-272-8373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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JYOTHSNA A VENKAT Ph. D
Primary Examiner
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